

REMARKS:

The Office Action dated October 19, 2007, has been received and carefully reviewed. The preceding amendments and the following remarks form a full and complete response thereto. Claims 1 and 9 have been cancelled without prejudice or disclaimer. Claims 2, 4-8 and 10-13 have been amended. New claims 14 and 15 have been added. No new matter has been added. Accordingly, claims 2-8 and 10-15 are pending in the application and submitted for reconsideration.

Objections were made to claims 6 and 10-12 for reasons relating to form. Claims 6 and 10-12 have been amended to correct any informalities. Accordingly, the Applicant requests that the objections be withdrawn.

Claim 9 was rejected under 35 U.S.C. §112 and 35 U.S.C. § 101. These rejections are now moot.

Claims 1, 4, 6, 8-9 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,651,753 to Lifton. Claims 1-2, 6, 8-9, 10 and 13 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 4,620,547 to Boebel. Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boebel '547 in view of U.S. Patent 5,106,364 to Hayafuji et al. Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over '547 to Boebel in view of '753 to Lifton. Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boebel '547 in view of U.S. Patent 4,254,762 to Yoon. Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boebel '547 in view of U.S. 2003/0181823 to Gatto. Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over

Boebel '547 in view of U.S. Patent 4,702,260 to Wang. Claim 13 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Boebel '547 in view of U.S. Patent 6,217,598 to Berman et al. Claim 10 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lifton '753 in view of Gatto '823. Claim 11 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Lifton '753 in view of Gatto '823.

The Applicant traverses each of the rejections and submits that claims 2-8 and 10-15 recite subject matter that is neither disclosed nor suggested by any combination of the cited prior art.

Each of the pending claims depend from claim 13, except for method claims 10-11. Claim 13 recites an optical biopsy instrument (100) that includes a substantially cylindrical cannula (22) with a proximal end (24) and a distal end (26). The cannula (22) has at least one lateral opening (28) in a side surface of the cannula (22). The instrument also includes an endoscope (10) which is axially movable inside the cannula (22). A clearance formed between the cannula (22) and the endoscope (10) is selected such that a separation of a tissue sample from a tissue is enabled by direct interaction of the endoscope (10) with the at least one lateral opening (28) by moving at least one of the cannula (22) and the endoscope (10) relative to each other.

Lifton and Boebel each fails to disclose such a configuration. Reference 17 of Lifton corresponds to a knife blade and reference 21 corresponds to a metallic tubing attached to the knife blade 17 (See, col. 3, lines 38-49 of Lifton). A knife blade is clearly different from an endoscope as required by present claim 13, since an endoscope necessarily comprises additional features such as, but not limited to, a fiber optic.

Moreover, the biopsy instrument disclosed by Lifton is to be used within an endoscope. In particular, it is intended to be passed through a corresponding port of an endoscopic fiber-optic instrument (see col. 1, lines 55-59 and col. 1, line 63 to col. 2, line 3 of Lifton.) Thus Lifton does not disclose an endoscope which is axially moveable *inside the cannula* as claimed in claim 13 of the present application.

Boebel discloses an optical biopsy instrument having an outer cylindrical cannula (outer shaft 1) that includes a lateral opening 2. Inside the cannula 1 is disposed an axially movable inner cannula 6 provided with a cutting edge 6. A biopsy sample is taken by suctioning tissue through the opening 2 into the cannula 1 and retracting the inner cannula 6. The instrument further comprises an endoscope (optical system 7) that is affixed to the inner cannula 6 at a site having an reduced diameter (see, Fig. 3 showing a cross-section along line 111-111 of Fig.2). Boebel does not disclose a clearance formed between the cannula 1 and the endoscope 7 selected to enable tissue sample separation by direct interaction of the lateral opening with the endoscope as defined by claim 13 of the present application.

None of the additional cited prior art cures the above-described deficiencies of Lifton and Boebel.

With respect to claims 10-11 and new claims 14-15, these method claims are patentable for at least the same reasons as those described above. Namely, claims 10 and 11 each recite a step of introducing an optical biopsy instrument (100), under endoscopic monitoring, into a duct wherein the optical biopsy instrument includes a

substantially cylindrical cannula (22) with a proximal end (24) and a distal end (26); the cannula (22) has at least one lateral opening (28) in a side surface of said cannula; an endoscope (10) which is axially movable inside the cannula (22); and a clearance formed between the cannula (22) and the endoscope (10) is selected such that a separation of a tissue sample from a tissue is enabled by direct interaction of the endoscope (10) with the at least one lateral opening (28) caused by moving at least one of the cannula (22) and the endoscope (10) relative to each other.

Thus, the Applicant submits that the cited prior art fails to disclose or suggest each and every element of claims 2-8 and 10-15. Accordingly, the Applicant requests that the rejections be withdrawn.

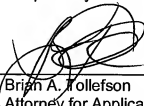
In view of the foregoing, the Applicant submits that claims 2-8 and 10-15 are in condition for allowance and request that claims 2-8 and 10-15 be allowed and this application passed to issue.

If for any reason the Examiner determines that the application is not now in condition for allowance, it is respectfully requested that the Examiner contact, by telephone, the Applicant's undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this application.

In the event that this paper is not timely filed, the Applicant respectfully petitions for an appropriate extension of time. Any fees for such an extension together with any additional fees maybe charged to Counsel's Deposit Account No. 02-2135.

Respectfully submitted,

By



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